

Appln. No.: 10/781,610  
Amendment Dated March 15, 2006  
Reply to Office Action of December 19, 2005

GRY-119US

**Remarks/Arguments:****BEST AVAILABLE COPY****Claim Status:**

Claims 2-11 are pending in this matter. Claim 1 has been cancelled without prejudice or disclaimer of the subject matter thereof. The features of claim 1 have been included in amended claims 6 and 7. Claims 2 and 8 have been amended to be dependent upon independent claim 6.

**Allowable Subject Matter:**

The Office Action dated December 19, 2005 indicates that claims 5 and 10 are both rejected and allowed. Specifically, the Office Action indicates that claims 5 and 10 stand rejected on the summary page and page 2, and the Office Action also indicates that claims 5 and 10 are allowed on page 3. Applicants will assume that the rejection of claims 5 and 10 was erroneous and the claims are in condition for allowance, unless advised to the contrary.

The Examiner objected to claims 6 and 7 as being dependent on rejected base claims, but indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicants appreciate Examiner's recognition of allowable subject matter. Claims 6 and 7 have been amended into independent form including all of the limitations of the respective base claims and any intervening claims.

For the purpose of clarity, it should not be disputed that claims 2-10 are in condition for allowance.

**Claim Rejection Under 35 U.S.C. §103:**

Claims 1, 2, 8, and 11 stand rejected under 35 USC 103(a) as being unpatentable over European Patent No. 0504806 to Wuebbeke in view of U.S. Patent No. 5,161,779 to Graner. Applicants respectfully traverse the rejection of these claims and respectfully submit that these claims are patentable over Wuebbeke and Graner for the reasons set forth below.

The Office Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the electromechanical actuator of Wuebbeke by placing a permanent magnet at the central portion of the circuit as taught by Graner et al. in order to reduce the amount of power needed to attract the moveable plate" (Page 3, Office

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Action dated December 19, 2005). Applicants respectfully disagree. Specifically, Applicants contend that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* (emphasis added)<sup>1</sup>

European Patent '806 to Wuebbeke discloses an electromagnetic valve having an E-shaped support 2, a moving core 3 and an intermediate part 4 positioned between the E-shaped support 2 and the moving core 3. ***The objective of the Wuebbeke invention is to achieve shorter switching times*** by decreasing the width of the moving core 3 (See Column 1, Lines 39-51). If a permanent magnet were positioned at the central portion of the circuit, as the Office Action proposes, the force exerted by the permanent magnet would increase the switching time of the valve as the core 3 moves ***away*** from the electromagnet. This is contrary to the teaching of Wuebbeke and, thus, Wuebbeke teaches away from the modification suggested in the Office Action. The only possible motivation to position a permanent magnet between Wuebbeke's electromagnet and moving core impermissibly comes from Applicants' own disclosure.

Accordingly, because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Wuebbeke reference or to combine reference teachings, and because Wuebbeke teaches away from the combination, prima facie obviousness cannot be established based on the cited references. Reconsideration of claim 11 is respectfully requested.

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<sup>1</sup> MPEP §706.02(j)

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## Conclusion:

In view of the claim amendments and remarks set forth above, Applicants respectfully submit that this application is now in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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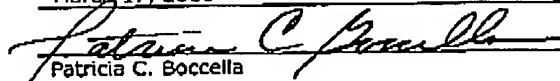
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March 17, 2006

  
Patricia C. Boccella

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